

Remarks

Claim 1-5 and 31-40 are pending.

Rejections Under 35 U.S.C. § 103

The Office has maintained the rejection of Claims 1-5 and 31-40 under Section 103 as being obvious over Hoppe (4278722) in view of Meunier (6582138).

Claims 1 and 32 require a fluid-based marking that comprises data for configuring an imaging device (Claim 1) or a fluid-based marking comprising media parameters corresponding to the sheet (Claim 32). The Office does not give these limitations patentable weight because, the Office asserts, they are a "recitation with respect to the manner in which a claimed product is intended to be employed...." Office Action, page 4. This assertion is not correct.

Both limitations are structural limitations, not a recitation of intended use. In Claim 1 the phrase "for configuring an imaging device" modifies "data." The single fluid-based marking comprises "data." What kind of data? Data for configuring an imaging device. This is a structural limitation on the fluid-based marking. This is no less a structural limitation simply because it suggests the fluid-based marking data will be used to configure an imaging device. Claim 1 does not recite that the fluid-based marking data must be used to configure an imaging device, but only that the fluid-based marking comprises data for configuring an imaging device. If the fluid-based marking were, for example, a bar code representing the characteristics of the paper on which it was applied (e.g., A4 size, 24 bond weight with a glossy finish), the paper would include a fluid-based marking comprising data for configuring an imaging device, without regard to if and how the paper was ever used. That is to say, the paper with such a marking meets this claim limitation when it is just sitting on the store shelf in a package whether or not the paper is ever placed into a printer and whether or not the marking is ever used to configure the printer. The same analysis applies to Claim 32.

For this reason alone, the rejections should be withdrawn.

Hoppe is nonanalogous art. The Office is obligated to show that a person of ordinary skill in the art of sensing media parameter information from print media would reasonably be expected to look to card laminating techniques like those disclosed

in Hoppe in resolving the problems noted in the Background section of the Specification. *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992); MPEP 2141.01(a). The Federal Circuit's decision in *In re Oetiker* is directly on point in the present case and the Examiner is urged to follow that decision.

"The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself.... *Oetiker's* invention is simple. Simplicity is not inimical to patentability." *In re Oetiker*, 24 USPQ 2d at 1446.

Hoppe teaches a lamination process for a layered identification card that allows printing over the full face of the card. In Hoppe, the lamination film 6 is so thin that the printed pattern on the face of the card may extend without interruption "over the film edge 7 and possibly over the subsequent identification-card edge 8." Hoppe, column 4, line 64 through column 5, line 4. It is just not reasonable to suggest someone skilled in the art of sensing media parameter information from the print media, Jean-Luc Meunier at Xerox or Bob Haines at Hewlett-Packard for example, would look to Hoppe to advance the art. Or, on the off chance that Messrs. Meunier and Haines should stumble across Hoppe, that they would suddenly realize the disadvantages of Mr. Meunier's edge coding and that they could and should extend Meunier's edge bar code up on to the face of the media. The Office's suggestion in this regard is just not plausible. Hoppe is no more related to what Meunier and Haines have done than is any other printed paper lamination technique.

If the Office disagrees, it is respectfully requested to produce evidence in the references themselves or in the knowledge generally available to those skilled in the art showing that a person of ordinary skill in the art seeking to improve sensing media parameters from the print media itself would reasonably be

expected to look to laminating techniques like those disclosed in Hoppe.¹ Absent such a showing, the rejections should be withdrawn.

Rejections Under 35 U.S.C. § 112

The Office maintains the rejection of Claim 3 under Section 112. The Office argues that Claim 3 reciting the marking imprinted on the edge portion and not imprinted on the facial portion appears to be contradictory to Claim 1 reciting the marking on a facial portion and on an edge portion. In reply to Applicant's response, the Office asserts that page 6 of the Specification teaches imprinting the marking on both the face and the edge. This assertion is not correct. The relevant portion of the Specification is quoted verbatim below.

"Specifically, Fig. 2 enlarges the ink-bled media marking of Fig. 1 to illustrate that the ink-bled media marking in *imprinted on an edge* 104 of the sheet of print media as well as *bled onto the face* 106 of the print media. The ink that has *bled onto the face* of the print media is shown in the shaded portion of 106 that intersects with the dotted line that circumscribes the marking 102.

Fig. 3 is a block diagram that shows an exemplary system 300 to imprint ink-bled media markings 102 of Figs. 1 and 2 onto a stack of print media 302 that includes respective sheets of print media 100 with a sufficient ink-wicking property. A sheet of print media is in a stack such as a ream of print media just prior to being packaged. An ink nozzle 302 of a printing system directs *an ink spray* 306 using a mask such as a marking mask (not shown) *onto the respective exposed edges* of each sheet in the ream. This technique forms exemplary ink-bled media markings 102 not only on the sprayed edges of the print media, but also on the faces 106 of the print media. Other methods besides spraying ink can be used *to imprint the ink-bled markings onto the edges* of the print media such as stamping the markings onto the edge of the ream, etc." Specification, page 6, lines 1-19 (emphasis added).

This description on page 6 clearly distinguishes the marking imprinted on the edge from the marking that bleeds on to the face from the marking imprinted on the

¹ The Federal Circuit Court of Appeals recently has again made it very clear that the Examiner has to produce evidence of a motivation or suggestion to combine references to arrive at the claimed structure to support an obviousness rejection. *In re Sang Su Lee*, Case No. 00-1158 (Decided January 18, 2002).

edge. ("[B]oth" on page 6, line 2, has been deleted to avoid any implication that the marking is imprinted on to the face.)

Claims 1 and 3 are consistent. Claim 1 requires only a marking positioned on a facial portion and an edge portion. Claim 1 does not limit how the marking comes to be positioned there. Claim 3 requires that the marking be imprinted on the edge portion and not imprinted on the facial portion. The marking, however, can still be positioned on the facial portion by, for example, bleeding from the edge portion on which it is imprinted as shown in Fig. 3 and described in the accompanying text at page 6 of the Specification.

Applicant again requests withdrawal of the Section 112 rejection.

The foregoing is believed to be a complete response to the outstanding Office Action.

Respectfully submitted,

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